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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,852	11/20/2003	Natasha P. Hixon	2916-4842. IUS	1905
24247	7590	05/24/2004		
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			EXAMINER CHOI, STEPHEN	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/718,852	Applicant(s) HIXON ET AL.	
	Examiner Stephen Choi	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/20/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 20 November 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because International Search Reports listed are not considered to be prior art and no explanation of the relevance of such reports to the present application is provided. It has been placed in the application file, but the list of such reports has been crossed out and has not been considered as to the merits.

Claim Objections

2. Claim 5 is objected to because of the following informalities: In claim 5, although the claim is reasonably understandable, "said at least one ejection element" lacks positive antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, it is not clear what structure is set forth by "said at least one cutting edge protrudes...". The sheet of material is not part of the invention.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 6-8, 11-12, 17-18, 23, 26-29, and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehlscheid et al. (US 4,537,588).

Ehlscheid discloses all the recited elements of the invention including:

- a) a substantially planar plate (1);
- b) at least one cutting edge protruding from a surface of the substantially planar plate a distance of about 0.015 inch to about 0.02 inch (col. 3, line 32).

It is noted that the plate can be configured to be secured to a portable die cutting apparatus. Regarding claim 7, col. 3, line 27. Regarding claims 8 and 23, col. 1, lines 44-47. Regarding claims 11 and 28, 0.2 mm is about 0.01 inch. Regarding claims 12 and 29, 0.5 mm is about 0.03 inch. Regarding claims 17 and 34, the plate has dimensions for compact and portable storage.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 2-5, 9-10, 13-16, 19-22, 24-25, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlscheid et al. (US 4,537,588) in view of Applicant's Admitted Prior Art (hereinafter AAPA).

Regarding claims 2-5 and 19-22, Ehlscheid discloses the invention substantially as claimed except for at least one compressible, resilient foam ejection member being positioned within a periphery defined by the at least one cutting edge. AAPA teaches the use of such an ejection member is old and well known in the art for the purpose of preventing the cut part from becoming trapped within the die. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the ejection member as taught by AAPA on the punch of Ehlscheid in order to facilitate removal of cutouts.

Regarding claims 9-10 and 24-25, Ehlscheid discloses the invention substantially as claimed except for the plate and at least one cutting edge comprises steel/ spring steel (claim 25). The use of steel/spring steel to make cutting dies is old and well known in the art as evidenced by Kang (US 5,379,671). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use steel/spring steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claims 13-16 and 30-33, Ehlscheid discloses the invention substantially as claimed except for peripheral dimensions of the plate of about 2 inches by about 2 inches. One having ordinary skill in the art would have been motivated to

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make the plate having different peripheral dimensions (e.g., 2" x 2") depending on sizes and shapes of cutouts as desired. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kang and Gerhardt.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday-Friday 9:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC
19 May 2004


STEPHEN CHOI
PRIMARY EXAMINER